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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/568,365	04/19/2007	Timothy Paul Woods	H0309.70013US00	1142
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EXAMINER				
SMALLEY, JAMES N				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/568,365

**Applicant(s)**

WOODS ET AL.

**Examiner**

JAMES N. SMALLEY

**Art Unit**

3781

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,5,6,8-12 and 15-19 is/are rejected.
- 7) ☒ Claim(s) 2,4,7,13 and 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 January 2011 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-940)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 04/19/2007
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

#### **DETAILED ACTION**

##### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

##### ***Claim Objections***

2. Claims 1-19 are objected to because of the following informalities: Claim 1, from which the remaining claims depend, limits "dampened hinging means." The proper engineering term is "damped." Also, in claim 8, "dampening" should be "damping." Appropriate correction is required.

##### ***Drawings***

3. The drawings were received on January 19, 2011. These drawings are not accepted. Figures 1-4 and 8 are too dark for details of the invention to be clearly seen.

##### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 5 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 5, it is not clear what the legal metes and bounds of the term "dead space" comprise.

Claim 7 recites the limitation "the charging aperture" in line 2. There is insufficient antecedent basis for this limitation in the claim. It appears the claim should depend from claim 2.

##### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 5, 6 and 15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edwards US 1,300,710 in view of Frei US 5,361,927, in view of Dolby US 4,940,191, and in view of Whitley US 5,102,002.

Foremost, Examiner notes the phrases "dampened hinging means" in claim 1, and "a dampening means" in claim 8 fail the 3-prong analysis described in MPEP 2181(I) in order to properly invoke 35 U.S.C. 112, 6<sup>th</sup> paragraph.

**Regarding claim 1**, Edwards '710 teaches in Figure 1 a self-closing receptacle (11) comprising an access aperture (unlabeled; read as the opening which is closed by the lid 14), and an access lid (14).

As applied, the reference teaches all limitations substantially as claimed, but fails to teach a damped hinging means.

Frei '927 teaches a damped hinge mounting mechanism, and discloses in col. 4, lines 24-27 that the invention "will allow a lid 80 of a bin 10 to remain in open position (25) long enough for the customer to remove baked goods without remaining open or slamming on the customer," after discussing doors slamming on customers in the Background of the Invention.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the container of Edwards '710, providing a damping hinge, such as that taught by Frei '927, motivated by the benefit of preventing the door from slamming down on a user.

Furthermore as applied, Edwards '710 teaches all limitations substantially as claimed, but fails to teach a suction cup affixed to the container to hold the lid for a pre-determined period of time. However, the reference does teach in col. 2, lines 100+, through col. 3, lines 1-6, that the closure can be held in an open position using handle (20) to locate pin (21) in opening (22).

Dolby '191 teaches it is known to provide a VELCRO-type fastening means (28, 30) on a container in order to hold a pivoted lid open, which would otherwise be biased towards the closed position due to the resiliency of the plastic hinge (32).

Whitley '002 is cited because it teaches, in col. 2, lines 43-46 that a suction cup is a known equivalent type of fastener as VELCRO.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Edwards '710, replacing the handle and locking pin, with a suction cup on the container, in order to hold the lid in an open position, as taught by the combined teachings of Dolby '191 and Whitley '002, motivated by the benefit of using a softer material which won't scratch or otherwise damage the container or lid surface. Moreover, the question is not whether the prior art devices can be physically combined, but whether a person of ordinary skill in the art would have found it obvious to combine different features or elements of known devices in a predictable way. See *Orthopedic Equip. Co. v. United States*, 702 F.2d 1005, 1013 (Fed. Cir. 1983): "There is a distinction between trying to physically combine the two separate apparatus disclosed in two prior art references on the one hand, and on the other hand trying to learn enough from the disclosures of the two references to render obvious the claims in suit. ...Claims may be obvious in view of a combination of references, even if the features of one reference cannot be substituted physically into the structure of the other reference."

**Regarding claim 5**, Examiner asserts the scoop is not positively claimed, and that it is only claimed as intended use. The bottom of the container of Edwards '710 is round, and thus has a shape complimentary to some types of scoops, such as those having a hemispherical shape.

**Regarding claim 6**, the embodiment of Figure 2 teaches a front, rear, two sides, and a base.

**Regarding claim 15**, legs (12) are read as a "display rack" and thus the container is "adapted" to be attached to the rack.

**Regarding claim 16**, the sides of the container in Edwards '710, Figure 2 are flat, and thus it is capable of being stacked side by side.

**Regarding claim 17**, the top of the body in Edwards '710, Figure 2 is curved at (24).

**Regarding claim 18**, the container body of Edwards '710 is adapted to house a scoop below the access lid because the container can hold objects, and is located below the lid, for example in Figure 1. Simply placing a scoop inside the container meets all claimed limitations. The claim is not narrow enough to limit a separate compartment.

**Regarding claim 19**, Edwards '710 fails to teach a seal; however, the reference does teach in col. 3, lines 50-53 that the container is intended to hold sugar.

Examiner takes Official Notice that it would have been obvious to modify the lid such that it forms an airtight seal with the container, in order to preserve the container contents, in view of MPEP 2144.03(A), as sealing containers is a fact "capable of such instant and unquestionable demonstration as to defy dispute."

8. Claims 8-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edwards US 1,300,710 in view of Frei US 5,361,927, in view of Dolby US 4,940,191, and in view of Whitley US 5,102,002, as applied above to claim 1, and further in view of Fukuo US 2003/0080131.

**Foremost, Examiner notes that while Frei '927 was used in claim 1 to teach it is known to provide a damping means to dampen the fall of a lid which closes automatically under gravity, the reference now becomes a linking reference, and is only used to teach the concept of dampening a lid's fall. Fukuo '131 is hereforth used to teach the actual dampening structures.**

**Regarding claim 8**, Edwards '710, as modified above in view of Frei '927, in view of Dolby '191, and in view of Whitley '002, teaches all limitations substantially as claimed, but fails to teach the damper comprising a dampening means cooperating with a pinion, and wherein the pinion interacts with an arm on the lid, having a rack on a longitudinal edge. Examiner notes the Random House Dictionary, copyright 2011 by Random House, teaches the definition of longitudinal is "extending in the direction of the length of a thing."

Fukuo '131 teaches a hinged opening and closing mechanism, which furthermore incorporates a damping means (6) interacting with a rack and pinion system. In this reference, the configuration is reversed: what is essentially a pinion is gear portion (37), attached to the lid, and an arm (27) acting as a rack and having teeth along its interior length, attached to the container. Although not directly attached to the asserted rack and pinion system (27, 37), the damping means (6) still "interacts" with the system because the damping means is attached to the pinion through-hole (36) as shown in Figure 1.

Examiner notes that although the system is biased towards the opening direction, one of ordinary skill would still appreciate and recognize that the damping system is still beneficial to lids or closures which are biased in the closing direction. Moreover, one having ordinary skill comparing the Fukuo '131 reference with the Edwards '710 reference would recognize that Edwards' biasing means of a lever arm (16) and counterweight (17) are fine and would not need modification. Because Edwards' lid operates about a hinge, and Fukuo's damping mechanism also operates about a hinge, the biasing spring in Fukuo is not relevant to the pivoting action, aside from providing a biasing force, i.e. if the spring is removed from Fukuo, the hinge still pivots and is damped, and is thus a distinct system from the spring.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the container and lid of Edwards '710 as modified above with respect to claim 1 in view of Frei '927 to provide damping means to prevent the lid from slamming shut, providing the damping means (6) and a rack and pinion gear system taught by Fukuo, because such is an equivalent mechanical system capable of slowing the closing motion. Examiner notes the question is not whether the prior art devices can be physically combined, but whether a person of ordinary skill in the art would have found it obvious to combine different features or elements of known devices in a predictable way. *See Orthopedic Equip. Co. v. United States*, 702 F.2d 1005, 1013 (Fed. Cir. 1983): "There is a distinction between trying to physically combine the two separate apparatus disclosed in two prior art references on the one hand, and on the other hand trying to learn enough from the disclosures of the two references to render obvious the claims in suit. ...Claims may be obvious in view of a combination of references, even if the features of one reference cannot be substituted physically into the structure of the other reference." Moreover, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system, reversing the working parts to provide the pinion (37) and damper (6) on the container, and the rack on the lid. It has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. *In re Einstein*, 8 USPQ 167.

**Regarding claim 9**, Examiner notes the phrase "which preferably" is not read a positive recitation of the limitation, and therefore, is not required in the prior art. Fukuo '131 teaches a damping oil in the last several lines of para. [0034].

**Regarding claims 10 and 11**, Fukuo '131 shows the pinion and damping means within a housing (24, 27) in the side of the container body. It would have been obvious to mount the pinion and damper of Fukuo '131 on the container of Edwards '710, in a housing, motivated by the benefit of recessing the elements from the surface to prevent someone from snagging their clothing in the gear system, and it would furthermore have been obvious to form the housing in the shape of a cylinder, motivated by the benefit of removing any pointed edges. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47.

**Regarding claim 12**, Fukuo '131 teaches the pinion and damper are mounted on a carrier (28) within the housing. Because this element is part of the collective gear system, it would have been applied on Edwards '710 per claim 9 above.

#### ***Allowable Subject Matter***

9. Claims 2-4, 7, 13 and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 7 is currently rejected under 35 U.S.C. 112, 2<sup>nd</sup> paragraph as lacking proper antecedent basis, but appears as if it should depend from claim 2.

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES N. SMALLEY whose telephone number is (571)272-4547. The examiner can normally be reached on Monday - Friday 11 am - 7:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Stashick can be reached on (571) 272-4561. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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